REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 3, 4, 7-9, 11, 12, 15-17, 19, 20, 23 and 24 have been amended. Claims 25-45 have been added. Claims 1-45 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims (e.g., including, but not limited to, the discussion of Figs. 1, 2, 3z, 3aa, 3bb, 5, 6, 7, 8a and 8b). No new matter has been added.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

35 U.S.C. § 112

The Office Action rejected claims 1, 9 and 17 under 35 U.S.C. § 112, second paragraph. Applicant has made an earnest attempt to amend the claims in a manner that overcomes such rejection. The amended claims no longer include the following phrases, which were cited in the Office Action: "*storing a version of a hardcopy paper*"; "*content of the likeness*"; "*the detected reference being associated with a second location*"; "*embedding a link within the version between the first location and the second location*"; and "*the first location being: displayable on the display device as part of the likeness.*"

35 U.S.C. § 103(a)

In the Office Action mailed July 26, 2005, claims 1, 3, 9, 11, 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0200507 ("Stern") in view of U.S. Patent No. 6,763,496 ("Hennings").

Stern is ***not*** a prior art reference in this case

As explained in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), Applicant's patent application claims priority to Applicant's U.S. Provisional Patent Application No. 60/208,015, filed ***May 26, 2000*** ("Applicant's May 26, 2000 Application"). By comparison, Stern's corresponding provisional patent application was subsequently filed ***June 16, 2000***. Thus, Applicant's May 26, 2000 Application was filed ***before*** Stern, and ***Stern is not a prior art reference in this case.***

Antecedent basis for claims 1, 3, 9, 11, 17 and 19 is located throughout Applicant's May 26, 2000 Application (e.g., including, but not limited to, the discussion at pages 10-15 of Applicant's May 26, 2000 Application). Applicant explained this fact in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), but the Examiner did not comment on this fact.

Thus, if the Examiner continues to rely upon Stern in rejecting claims 1, 3, 9, 11, 17 and 19, then Applicant respectfully submits that the Examiner should ***not*** issue a "final" Office Action in this case, until after the Examiner: (a) explains how Stern qualifies as a prior art reference; and (b) permits Applicant to address such explanation in a subsequent Response to Office Action.

Hennings fails to teach claims 1, 3, 9, 11, 17, 19, 43, 44 and 45

Hennings fails to teach the combination of elements in claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, and Hennings also fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does ***not*** render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..."

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's

disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 3, 9, 11, 17, 19, 43, 44 and 45.

Dependent claims 2, 5-8 and 25-30 depend from and further limit claim 1 and therefore are allowable.

Dependent claim 4 depends from and further limits claim 3 and therefore is allowable.

Dependent claims 10, 13-16 and 31-36 depend from and further limit claim 9 and therefore are allowable.

Dependent claim 12 depends from and further limits claim 11 and therefore is allowable.

Dependent claims 18, 21-24 and 37-42 depend from and further limit claim 17 and therefore are allowable.

Dependent claim 20 depends from and further limits claim 19 and therefore is allowable.

An early formal notice of allowance of claims 1-45 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:

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